

REMARKS

This Amendment And Request For Reconsideration is submitted in response to the Office Action mailed on 22 January 2009 for the above-identified patent application.

In the present Amendment, the Applicants amend claims 1-17, 33-34, 37-38, 40-43, 45, and 47-48; no claims have been added or canceled. The Applicants respectfully submit that no new matter has been presented; the amendments and new claims are supported by the application as originally filed. Thus, claims 1-53 as amended are pending in the application for reconsideration.

In the Office Action mailed on 22 January 2009, the Examiner rejected claims of the present application under 35 U.S.C. § 103(a) based on what is deemed Applicant's Admitted Prior Art "AAPA" (pages 2-3 of the present application) in view of Bridges et al. (U.S. Patent No. 7,096,015). In response, the Applicants respectfully disagree with these rejections, and submits that the claims as amended are allowable over the prior art of record for at least the following reasons.

1. Bridges Et Al. Fail To Teach Or Suggest A Home Public Land Mobile Network (HPLMN) That Is Prioritized For Selection In Response To Regaining Signal Coverage Or Powering On As Claimed.

In order to properly establish rejections under 35 U.S.C. § 103(a), the prior art in combination must teach or suggest each and every limitation of the claims. In the present case, the relied upon art fails to teach or suggest each and every limitation of the claims.

Claims 1-17, 33-43, and 50-53 recite limitations relating to a "mobile station which is associated with a Home Public Land Mobile Network (HPLMN) identified by a home Mobile Network Code (MNC) and Mobile Country Code (MCC) pair" which prioritizes the "selecting and operating with the HPLMN" where "the HPLMN identified

by the home MNC/MCC pair is available" in response to regaining signal coverage or powering on.

In the present case, the relied upon art fails to teach or suggest the prioritization of an HPLMN identifiable by a home MNC/MCC pair in response to the recited conditions.

The Examiner's rejection is based on the combined teachings of the Examiner's alleged AAPA and Bridges et al. Specifically, the Examiner asserts that "Bridges et al. disclose ... [that] the mobile station performs selecting and operating with the home communication network as a first priority if a home communication network of the mobile station is identified as being available."

However, Bridges et al. do not teach or suggest an HPLMN identifiable by a home MNC/MCC pair, which is prioritized for selection in response to the recited conditions. In contrast, the teachings of Bridges et al. primarily focus on systems (e.g. IS-136) that utilize system identification codes (SIDs) and system operator codes (SOCs) – not MNC/MCC pairs as claimed.

It is important that standards are adhered to when developing technologies. One ordinarily skilled in the art would appreciate the different technology standards (i.e. for network selection) that are adhered to for different communication systems.

Bridges et al. even acknowledge of the importance of *adherence and compatibility* to standards in column 4 at lines 58-65:

Further, there is a need to provide intelligent roaming capabilities for a mobile station which will not require any changes to present network interface standards (e.g. IS-41) or air interface standards (e.g., IS-136, IS-91A, IS-95). Such features are desirable in order to permit new intelligent roaming capabilities to be readily utilized by a mobile station and to allow seamless integration of such capabilities without modification to present industry standards.

The above passage suggests that Bridges et al. would be sensitive to adherence to communication standards, and not readily modify aspects relating to standards.

Thus, it is clear that Bridges et al. fail to teach or suggest an HPLMN identifiable by a home MNC/MCC pair which is prioritized for selection in response to the recited conditions.

Based on these reasons alone, the Applicants respectfully request the Examiner to withdraw the rejections and allow the claims.

2. One Ordinarily Skilled In The Art Would Not Have Modified Cellular Telecommunication Standards ("AAPA") With The Teachings Of Bridges Et Al. As Fashioned By The Examiner.

In order to properly establish rejections under 35 U.S.C. § 103(a), there must also be a proper obviousness/non-obviousness assessment that includes some adequate reasoning and/or demonstration that one ordinarily skilled in the art would have combined the teachings of the references to produce that which is claimed.

When considering various prior art teachings for an obviousness/non-obviousness determination under §103,

the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or non-obviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. *Graham vs. John Deere Co. of Kansas City*, 383 U.S. 1, pp 17-18 (1966).

In this analysis, a functional approach may be taken which asks whether the improvement of the presented invention is more than a predictable use of prior art

elements according to their established functions. It is also helpful and instructive to consider whether there is any teaching, suggestion, or motivation to combine the teachings of the references, either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art, in a flexible and non-rigid manner. The reason or evidence of a motivation to combine teachings need not be found explicitly in the prior art references, as one may also “look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art.” *KSR Int’l Co. v. Teleflex Inc. et al.*, 127 S.Ct. 1727, at 1740-41.

The Applicants respectfully submit that one ordinarily skilled in the art would not have been inclined to combine the teachings of the alleged AAPA with Bridges et al. in the manner the Examiner fashions in the rejection of claims 1-17, 33-43, and 50. When making a proper assessment of obviousness/non-obviousness in the present case, which considers *the prior art as a whole* including long felt but unsolved needs, and failure of others, the techniques of the present disclosure are non-obvious.

The Examiner’s rejection is based on the combined teachings of the Examiner’s alleged AAPA and Bridges et al. However, the alleged AAPA is actually derived from cellular telecommunications standards, as stated in the application (see e.g. page 2 at lines 31-32 of the present application). *It may be said that the standards describe network selection techniques from the collective minds of those ordinarily skilled in the art.*

The Applicants submit as Attachment A the 3GPP TS 23.122 V5.3.0 (2003-09), for example, which describes network selection in the 3GPP context. In section 4.4.3.1 (“At switch-on or recovery from lack of coverage”) on page 14 of this standard, it is stated that

4.4.3.1 At switch-on or recovery from lack of coverage

At switch on, or following recovery from lack of coverage, the MS selects the registered PLMN ...

If there is no registered PLMN, ... the MS follows one of the following two procedures [i.e. 4.4.3.1.1 Automatic Network Selection Mode Procedure, and 4.4.3.1.2 Manual Network Selection Mode Procedure] depending on its operating mode...

4.4.3.1.1 Automatic Network Selection Mode Procedure

The MS selects and attempts registration on other PLMNs, if available and allowable, in the following order:

- i) HPLMN (if not previously selected);
- ii) each PLMN in the "User Controlled PLMN Selector with Access Technology" data field in the SIM (in priority order);
- iii) each PLMN in the "Operator Controlled PLMN Selector with Access Technology" data field in the SIM (in priority order)

Thus, per the standards, after recovering from an out-of-coverage condition, a mobile station operates to select the PLMN with which it had just previously registered (i.e. its "RPLMN"). If the RPLMN is unavailable, the mobile station performs a scan to identify and select a PLMN which may be the HPLMN.

However, the specifications do not adequately address the situation where the RPLMN is not the HPLMN of the mobile station. If the RPLMN is not the HPLMN, and

the HPLMN is available after the recovery from the out-of-coverage condition, it is specified that the mobile station is limited to selecting the non-home RPLMN (if available) upon recovery. This problem is described on page 19 at lines 26-31 of the present application:

a problem that the specifications do not clearly and specifically address: the situation where the RPLMN is not the HPLMN of the mobile station. If the RPLMN is not the HPLMN, and the HPLMN is available after the recovery from the out-of-coverage condition or after power-on, the standards specify that the mobile station is limited to selecting the non-home RPLMN (if available).

Again, the Examiner's rejection is based on the combined teachings of the Examiner's alleged AAPA and Bridges et al. However, Bridges et al. do not teach or suggest an HPLMN identifiable by a home MNC/MCC pair, which is prioritized for selection in response to the recited conditions. In contrast, the teachings of Bridges et al. is primarily directed to systems utilizing system identification codes (SIDs) and system operator codes (SOCs) (e.g. IS-136) – not systems utilizing MNC/MCC pairs and HPLMNs/RPLMNs as claimed.

One ordinarily skilled in the art would appreciate that the different technologies presented are not compatible, as different standards are suitably developed for different systems. It is important that standards are adhered to in technology development. Operation per standards is ordinarily required to ensure proper operation and compatibility.

Bridges et al. even acknowledge of the importance of *adherence and compatibility* to standards in column 4 at lines 58-65:

Further, there is a need to provide intelligent roaming capabilities for a mobile station which will not require any changes to present network interface standards (e.g. IS-41) or air interface standards (e.g., IS-136, IS-91A, IS-95). Such

features are desirable in order to permit new intelligent roaming capabilities to be readily utilized by a mobile station and to allow seamless integration of such capabilities without modification to present industry standards.

The above passage suggests that Bridges et al. would be sensitive to adherence to communication standards, and not readily modify aspects relating to standards. This is true in the present case.

Considering the above, one ordinarily skilled in the art would not have modified the standards based on the teachings of Bridges et al.

The Examiner asserts that one ordinarily skilled in the art would have combined these teachings in order "to adapt the teaching of Bridges et al. for selecting the home communication network as a first priority to the network selection method of the AAPA in order to save cost to the user." However, one ordinarily skilled in the art would have taken into account the above, as well as other considerations: notably, while roaming, a mobile station will ordinarily not find its HPLMN. *Therefore, the mobile station's step of attempting to find the HPLMN may add an unnecessary and unacceptable delay to obtain service.*

Thus, considering *the prior art as a whole* including long felt but unsolved needs, and failure of others, the techniques of the present disclosure are clearly non-obvious. The Applicants respectfully request the Examiner to withdraw the rejections of claims 1-17, 33-43, and 50-53 and allow such claims.

3. The Examiner Fails To Adequately Demonstrate That The Prior Art In Combination Teaches Or Suggests Many Limitations In Claims 18-32 and 44-49.

The Examiner's rejection of claims 18-32 and 44-49 is based on the combined teachings of the Examiner's alleged AAPA and Bridges et al. In response, the Applicants respectfully submit that the Examiner has also not set forth any proper rejection for the teaching of the limitations of these claims.

For one, the Examiner alleges that the AAPA teach certain limitations of these claims. In response, the Applicants respectfully disagree. The description referred to by the Examiner addresses an automatic selection technique, not any manual selection technique where a manually-selected network is utilized for operation. There are only a couple of sentences near the end of the "Description Of The Related Art" that mention manual network selection. Thus, the Examiner fails to identify prior art that relates to "manual selection" in the network selection method claimed in claims 18-32 and 44-49.

Further, the Applicants respectfully submit that one ordinarily skilled in the art would not have been inclined to combine the teachings of the alleged AAPA with Bridges et al. in the manner the Examiner fashions, for the same or similar reasons as provided above.

Finally, even if one ordinarily skilled in the art would have combined such teachings, the Examiner alleges that Bridges' teaching would provide that the home communication network would be selected as a first priority. However, what is claimed is "if the non-home communication network is identified as being available, selecting and operating with the non-home communication network"; therefore, the non-home communication network is the first priority in these claims. Thus, the resulting combination would fail, since that is not what is claimed.

As described previously, an issue associated with the earlier-described problem of prior art techniques relates specifically to claims 18-32 and 44-49. In particular, GSM standards specify that if the last RPLMN is unavailable while the mobile station is in "manual" network selection mode, the mobile station shall camp on any network providing emergency service. This selected network, however, may not be the optimal network with which to operate, especially, for example, if the home network is made available.

The present application is directed further to a solution to this additional problem with manual network selection, and is defined in claims 18-32 and dependent claims 44-49. The prior art of record fails to teach or suggest other steps which occur

"in response to regaining signal coverage from an out-of-coverage condition with the manually-selected non-home communication network" or "in response to being powered-on from a power-off state entered while in the manual network selection mode." In particular, the prior art fails to teach the following steps which are utilized after such events: "if the non-home communication network is unavailable and the home communication network is also unavailable: displaying a list of available communication networks for a manual network selection procedure for manual network selection and operation with one of the available communication networks" and "if the non-home communication network is unavailable but the home communication network is identified as being available: instead of carrying out the manual network selection procedure for the manual network selection and operation with one of the available communication networks, selecting and operating with the home communication network."

The above-stated and claimed techniques are advantageous, for example, as described on page 22 at lines 1-5:

Advantageously in FIG. 7, even in a manual selection mode where choices are made by the end user, the mobile station makes the end user aware of recent availability of the home network in a timely and unobtrusive fashion. Overall, the mobile station helps facilitate the selection of the best network for the end user even in the manual selection mode.

Based on the above, the rejection of claims 18-32 and 44-49 should also be withdrawn and the claims should be allowed.

Additional reasons for the further allowability of both the independent and dependent claims are apparent to those of ordinary skill in the art, but are not articulated herein due to the reasons already presented above.

As explained above, the prior art in combination fails to teach, suggest, or render obvious claims 1-53, and therefore such claims are allowable over the prior art of record. The Applicant respectfully requests reconsideration of the claims and allowance of the application as all statutory requirements have now been met.

Thank you. Please feel free to contact the undersigned if there are any questions or concerns regarding this submission.

Respectfully submitted,

/John J. Oskorep/

Date: 22 April 2009

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